

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Stephane Taunier *et al.*
Appl. No. : 10/540,729
Filing Date : June 24, 2005
For : Method of Producing Thin Films of Compound I-III-VI,
Promoting the Incorporation of III Elements in the Film
Examiner : Arun S. Phasge
Art Unit : 1795
Atty. Docket : 16721-0290 (42528-317078)
Patent No. :

Mail Stop: Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Communication Regarding Patent Term Adjustment (PTA)
Indicated in Notice of Allowance

Sir:

1. A Notice of Allowance was mailed on February 1, 2010 for the present application. One of the attachments to the Notice of Allowance was a Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) that indicated that the total PTA to date is 821 days. It is believed that the correct total PTA to date is at least 1188 days.

2. The determination of the total PTA of 821 days is erroneous because the U.S. Patent and Trademark Office's (USPTO) PTA calculator failed to account for two separate USPTO delays. The two USPTO delay periods should have their days added together in accordance with the reasoning in *Wyeth et al. v. Dudas*, No. 07-1492 (D.D.C. September 30, 2008). The number of PTA credits of 853 days for USPTO delay under 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. 1.702(a)(1) that is set forth on the enclosed PTA History (Exhibit A) is correct but it only accounts for one of the delays

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this submission is being filed via EFS
Web with the U.S. Patent and Trademark Office on April 30, 2010.

/Sandee Hampton/
Sandee Hampton

of the USPTO. The other delay warrants a PTA credit of at least 367 days for USPTO delay under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b). Applicants are entitled to the sum of these two periods, excluding the overlapping periods of delay.

Accordingly, a total PTA credit of at least 1200 days (i.e., 853 days + 367 days) is appropriate based upon the USPTO delay. The total number of PTA debits of 32 days for applicant delay that is set forth on the enclosed PTA History (Exhibit A) is correct. Thus, the correct total PTA to date is at least 1188 days (i.e., 1200 days – 32 days).

Thus, Applicants believe that the total PTA credit for USPTO delay is at least 1200 days, the total PTA debit for applicant delay is 32 days, and the total PTA under § 1.703(f) is at least 1188 days.

3. In accordance with § 1.705(d), this application for patent term adjustment is filed no later than the payment of the issue fee but after the date of mailing of the notice of allowance.

4. The following statements are required by 37 C.F.R. § 1.705(b)(2)(i).

- i) The correct total PTA credit is at least 1188 days.
- ii) The basis for the 853 days PTA credit is under §§ 1.702(a)(1) and (a)(2) and is due to the USPTO's failure to mail a notification under 35 U.S.C. § 132 or a notice of allowance within 14 months of the application's filing date. The basis for the at least 367 days is under § 1.702(b) and is due to the USPTO's failure to issue a patent within three years of the filing date.

5. The following statements are required by 37 C.F.R. § 1.705(b)(2)(ii).

- i) The relevant dates as specified in § 1.703(a) for one part of the PTA credit are as follows:

(a) The date of August 26, 2006, which is the date that is fourteen months after the date on which the application was filed under 35 U.S.C. § 111(a); and the date of December 26, 2008, which is the mailing date of a notification under 35 U.S.C. § 132.

Thus, this period of delay runs from August 26, 2006 to December 26, 2008. This period of delay is 853 days.

(b) The date of September 10, 2009, which is the date that is three months after the date on which a Non-Final Office Action was issued; and the date of October 12, 2009, which is the date a response was submitted to the USPTO. Thus, this period of applicant delay runs from September 10, 2009 to October 12, 2009. This period of delay is 32 days.

Thus, the total period of delay for this part of the PTA credit is 821 days (853 - 32).

- ii) The relevant dates as specified in § 1.703(b) for the other part of the PTA credit are as follows: the date of June 26, 2008, which is three years after the date on which the application was filed under 35 U.S.C. 111(a); and February 1, 2010, the date the notice of allowance was issued. Thus, the period of delay runs from June 26, 2008 to February 1, 2010, excluding the number of days in the period beginning on the date of December 27, 2008 and ending on September 9, 2009 and also excluding the number of days in the period beginning on the date of October 13, 2009 and ending on February 1, 2010. The above-mentioned exclusion periods represent overlapping periods of delay. Including these exclusion periods, the resulting period of delay is at least 367 days.
- iii) The total PTA under § 1.703(f) is 1188 days, which is the total PTA credits for USPTO delay of 853 days plus at least 367 days less the total PTA debits for applicant delay of 32 days.

6. Any patent granted on this application is not subject to a terminal disclaimer. See 37 C.F.R. § 1.705(b)(2)(iii).

7. The following statements are required by 37 C.F.R. § 1.705(b)(2)(iv)(A):

i) The Response after Non-Final Office Action filed October 12, 2009 was filed after the three month period for filing a response. Under § 1.704(b), the period of adjustment for delay associated with this reply begins on the day after the date that is three months after the date of mailing of the Office Action on September 10, 2009 and ends on the date the reply was filed. Thus, the period of delay runs from September 10, 2009 to October 12, 2009. This period of delay is 32 days.

Thus, the total period of delay for applicant delay is 32 days.

The Commissioner is authorized to charge any additional fees that may be due or credit any overpayment to Deposit Account No. 11-0855.

Respectfully submitted,



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Encl.: Exhibit A - Copy of PTA History for Application No. 10/540,729 Printed from PAIR on April 29, 2010.

EXHIBIT A



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Patent Term Adjustment		Foreign Priority Data		Review					
Patent or 371(c) Date: Issue Date of Patent: Pre-Issue Petitions (days): Post-Issue Petitions (days): USPTO Adjustment (days):		06-24-2005		USPTO Delay (PTO) Delay (days): Three Years: Applicant Delay (APP) Delay (days): Total Patent Term Adjustment (days): Explanation Of Calculations i		-		-	
Patent Term Adjustment History		Date		Contents Description		PTO (Days)		APPL (Days)	
Patent Guidance and General Info Codes, Rules & Manuals Employee & Office Directories Resources & Public Notices		02-01-2010 02-01-2010		Mail Notice of Allowance Document Verification					
Other		02-01-2010 01-29-2010 11-22-2009 10-12-2009 10-12-2009 06-10-2009 06-08-2009 03-31-2009 03-26-2009 12-26-2008 12-22-2008 09-12-2005 10-05-2007 03-28-2006 03-28-2006 09-12-2005 09-12-2005		Notice of Allowance Data Verification Completed Examiner's Amendment Communication Date Forwarded to Examiner Response after Non-Final Action Request for Extension of Time - Granted Mail Non-Final Rejection Non-Final Rejection Date Forwarded to Examiner Response after Non-Final Action Mail Non-Final Rejection Non-Final Rejection Information Disclosure Statement considered Case Docketed to Examiner in GAU IFW TSS Processing by Tech Center Complete Case Docketed to Examiner in GAU Reference capture on IDS Information Disclosure Statement (IDS) Filed		32		32	
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09-12-2005	Information Disclosure Statement (IDS) Filed
03-14-2006	Cleared by OIPE CSR
03-14-2006	Cleared by OIPE CSR
03-14-2006	Cleared by OIPE CSR
06-26-2005	371 Completion Date
03-03-2006	Application Return from OIPE
03-03-2006	Notice of DO/EO Acceptance Mailed
03-03-2006	Application Return TO OIPE
02-28-2006	Application Dispatched from OIPE
02-28-2006	Notice of DO/EO Acceptance Mailed

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